

REMARKS

I. Status of the Application

In view of the above amendments and the following remarks, reconsideration of the rejections and objections set forth in the Office Action of March 1, 2010 is respectfully requested.

By this amendment, claims 1, 3, 21, 25, 32, 36, and 40 have been amended; no new matter has been added by these amendments. Claims 1, 3, 15-26, 28-30, 32-43 are now pending in the application.

The specification has been reviewed and revised. No new matter has been added by these revisions. Entry of the specification amendments is respectfully requested.

II. Specification

On page 2 of the Office Action, the specification is objected to regarding several minor typographical errors. The specification has been amended to correct these errors, and withdrawal of this objection is thus respectfully requested.

III. 35 U.S.C. § 112

On pages 2 and 3 of the Office Action, many of the pending claims are rejected as being indefinite for including an unclear recitation.

Claims 1 and 25 have been amended to clarify that the word “closed” refers only to the closed pores and not to the recesses of the sintered sliding body. This subject matter is clearly described on at least page 27 of the specification, which describes the recesses (29) as being dimples or holes, and figure 8B, which depicts the dimples (29) as being exposed on the sliding

surface. Moreover, it was agreed in the interview of May 20, 2010 that such an amendment overcomes the indefiniteness rejection set forth in item 5 on pages 2 and 3 of the Office Action.

Regarding item 4 on page 2 of the Office Action, Applicants traverse this rejection for the following reasons. The MPEP and applicable case law establish that breadth of a claim does not constitute indefiniteness. (MPEP 2173.04; “Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.”) In the present case, the lack of a limiting adjective such as “open” or “closed” describing the claimed recesses is a matter of breadth rather than indefiniteness; while the claims are broader than they would be if such a limitation was included, the scope of the claims is clear and thus not indefinite. Withdrawal of this rejection is thus respectfully requested.

Regarding item 5 on page 3 of the Office Action, claim 3 has been amended to provide proper antecedent basis; withdrawal of this rejection is thus respectfully requested. It is noted that claims 21, 32, 36, and 40 have also been amended to correct minor informalities.

IV. Interview of May 20, 2010

Applicants thank the Examiner for the helpful comments provided in the interview of May 20, 2010. In that interview, it was agreed that the above-discussed amendments would overcome the indefiniteness rejections. The prior art rejections set forth in the Office Action were also discussed in the interview. In particular, Applicants disagree with the prior art rejections, as discussed in more detail below, and while the Examiner did not immediately agree

with the arguments made in the interview, the Examiner did agree to consider these remarks and provide a detailed response thereto.

V. Prior Art Rejections

Beginning on page 3 of the Office Action, several prior art rejections are set forth; the prior art rejections are as follows:

- A. All of the pending claims except claims 17 and 34 are rejected as being obvious over Sakai et al. (JP 02138442) in view of Takeshi et al. (JP 08-109450) in view of Tanaka (US 5,328,772) or Komura (US 5,675,201) or Schulz (US 3,424,503).
- B. All of the pending claims except claims 17 and 34 are rejected as being obvious over Sandberg (US 7,297,177) or Pinnow (US 5,936,169) in view of Takeshi et al. or Morishita et al. (JP 363262402) or Tanaka or Komura or Schulz.
- C. Claims 1, 3, and 16 are rejected as being obvious over Non-Patent Literature disclosed as document AO on the IDS of January 5, 2006 (herein referred to as “NPL”) in view of Takeshi et al.

As a preliminary matter, it is noted that the above-summarized prior art rejections are set forth in items 8, 9, 10, and 11 on pages 3 and 4 of the Office Action. While it is unclear from the Office Action itself whether the references listed in item 11 on page 4 of the Office Action constitute a separate rejection or a modification of the other prior art rejections, the Examiner clarified in the interview that these references are additional secondary references which modify the prior art rejections of items 8 and 9. Applicants respectfully request that if any prior art rejection is asserted in any future office action, that the individual prior art references which are

applied to each claim be clearly and specifically identified, and that the limitations which are referred to within the Office Action be identified with the relevant claim number.

Each of the prior art rejections A and B is contingent on an assertion that the limitation “solid soluble carbon of 0.15 to 0.5wt%” recited in claim 1 “would be expected since composition and process of making by sinter bonding are closely met and in absence of evidence to the contrary.” (Emphasis added, see item 10 on page 3 of the Office Action of July 16, 2009 with respect to rejection A, and see item 32 on page 8 of the Office Action of July 16, 2009 with respect to rejection B.) Rejection C contains the very similar assertion that “although martensite phase is not disclosed, such would be expected since composition and carbide limitation are closely met.” (See item 37 on page 10 of the Office Action of July 16, 2009.) As discussed in the response of January 11, 2010, a claim limitation is not met merely by asserting that it would be “expected” to be present in the prior art because the prior art discloses a similar composition. To the contrary, each and every limitation of a claim must be present in the prior art in order to support a prior art rejection. Prior art rejections A, B, and C do not assert that the claim limitations are disclosed in the prior art, they do not assert that these limitations would be inherent, and they do not assert that it would have been obvious to modify the prior art to have these limitations. Accordingly, these prior art rejections are improper for failing to show that each and every limitation is met by the prior art.

In responding to the above arguments on pages 6 and 7 of the Office Action of March 1, 2010, it is asserted that MPEP 2112.01 supports the “closely met” rationale of prior art rejections A, B, and C. However, that portion of the MPEP provides that when the structure recited in the reference is substantially identical to that of the claims, claimed properties or functions are presumed to be inherent. As an example of “claimed properties,” that section of the MPEP

discusses case law in which an applicant claimed “corrosion resistance” as a property. Other examples of properties would be water soluble, reflective, durable, or impact resistant. However, in the instant case, the solid soluble carbon content of .15 to 0.5wt% recited in claim 1 is not a property, but rather a chemical composition. Similarly, the martensite phase recited in claim 1 is not a property, but rather a structural limitation. Neither MPEP 2112.01 nor any other portion of the MPEP supports the proposition that limitations regarding a chemical composition or structural configuration are inherent merely because other claim limitations are disclosed in the prior art. Because MPEP 2112.01 does not support the “closely met” obviousness rationale, each of the prior art rejections A, B, and C are improper, and no prima facie case of obviousness has been established with respect to the pending claims.

Moreover, in discussing this matter during the telephone interview, the Examiner seemed to agree with the arguments above, but stated that the carbon content and martensite phase requirements of claim 1 might nevertheless be inherent in the prior art. Applicants note that inherency only exists where a claimed feature is definitely and unequivocally present in the prior art. (MPEP 2112; “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’”) Clearly, all ferrous sintered components having a carbide content of 5 to 50% are not necessarily in the martensite phase and do not necessarily have the claimed solid soluble carbon concentration of 0.15 to 0.5wt%. Accordingly, no inherency exists as to these limitations.

Further, it appears as though there would have been no reason to modify any of the prior art of record to yield a configuration which would meet the requirements of the pending claims. It is thus submitted that the invention of the present application is not anticipated nor rendered obvious by the prior art, and yields significant advantages over the prior art. Allowance is respectfully requested.

In view of the foregoing amendments and remarks, inasmuch as all of the outstanding issues have been addressed, it is respectfully submitted that the present application is now in condition for allowance, and action to such effect is earnestly solicited. Should any issues remain after consideration of the response, however, the Examiner is invited to telephone the undersigned at the Examiner's convenience.

Respectfully submitted,

Takemori TAKAYAMA et al.

By 

Digitally signed by /Andrew D. St.Clair/
DN: cn=/Andrew D. St.Clair/, o, ou,
email=astclair@wenderoth.com, c=US
Date: 2010.08.25 13:49:04 -04'00'

Andrew D. St.Clair
Registration No. 58,739
Attorney for Applicants

ADS/rgf
Washington, D.C. 20005-1503
Telephone (202) 721-8200
Facsimile (202) 721-8250
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